

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 043931-0122

In re Patent Application of

JOBST U. GELLERT

Serial No. 09/411,400

Filed: October 4, 1999

For: AN INJECTION MOLDING NOZZLE TIP WITH INSERT

Group Art Unit: 3729

Examiner: Sean P. Smith

**REQUEST FOR WITHDRAWAL
OF OFFICE ACTION**

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a request to withdraw the final Office Action dated January 2, 2002, in the above-captioned application, because the Office Action is incomplete. This paper also confirms the substance of a telephone interview between the undersigned and Examiner Smith on January 11, 2002.

PROSECUTION HISTORY

Claims 15-26 and 49-56 were examined in the preceding Office Action, dated May 22, 2001. In reply to that Office Action, Applicant filed an Amendment on September 20, 2001, amending certain claims, adding new claims 57 and 58, and canceling claims 15, 17, 22, 49, 50 and 51. Thus, claims 16, 18, 19-21, 23-26 and 52-58 were presented for reconsideration. Claims 19, 24 and 53 are the only independent claims.

THE FINAL OFFICE ACTION

The Office Action Summary

Although not substantively critical, Applicant takes this opportunity to note several errors in the Office Action Summary.

Firstly, the Summary states that the Office Action is responsive to a communication filed "Feb 20, 2001" – an incorrect date. While an Amendment indeed was filed on that date, it was already addressed by the PTO in the Office Action of May 22, 2001.

Secondly, under "Disposition of Claims" it is said that claims "16-21, 23-26, and 52-56" are pending. This is in error. As noted above, claims 16, 18, 19-21, 23-26 and 52-58 were presented for reconsideration in the last Amendment.

Thirdly, under "Attachments" it is said that a "Notice of References Cited, PTO-892" is attached. However, no such form – and no new references – accompanied the Office Action received by Applicant's attorney.

The Rejection(s)

Most importantly, the final Office Action is completely silent about new claims 57 and 58; and there is no clear statement of rejection of some of the other claims, even though they are compared to one of the references.

On page 2 of the Office Action, ¶2 states that "Claims 19, 16, 24-26, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gellert in view of Gellert (5051086)." (Applicant assumes that the first-mentioned Gellert reference is US 4,768,283, of record, because of the later mention of "Gellert 283"; and that the second-mentioned Gellert reference is the new reference that should have been supplied with the Office Action and listed on a form PTO-892.) The same claims are then mentioned in the next paragraph, and the two paragraphs that follow seem to discuss the prior art in relation to those claims.

Starting with the first full paragraph on page 2, the Office Action then compares *other* claims ("18 and 26"; "20, 21, 52 and 54-56"; "22 and 23") to a "Gellert" reference (the patent number is not specified). However, these paragraphs are not preceded by a clear statement of rejection of these claims, i.e., there is no statement there that these claims "are rejected," and no statutory basis given for any rejection. From the Office Action Summary it appears that a rejection was intended, but it is not specified in the body of the Office Action. Note that claims 57 and 58 are not mentioned at all.

Withdrawal is Essential

Clearly the final Office Action cannot remain outstanding because it renders the status of the claims incomplete, unclear and uncertain. The record is confusing at best, and Applicant cannot fashion a complete and meaningful response.

An Office Action must be "complete as to all matters...." 37 C.F.R. §1.104(b); M.P.E.P. §707.07. "Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection clearly stated, and the word 'reject' must

be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection." M.P.E.P. §707.07(d) (emphasis in original). Further, "In every office action, each pending claim should be mentioned by number, and its treatment or status given." M.P.E.P. §707.07(i). Measured by these standards, the final Office Action is incomplete and must be withdrawn.

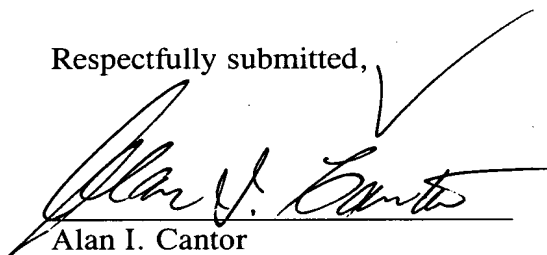
CONCLUSION

For the foregoing reasons, it is respectfully requested that the final Office Action mailed January 2, 2002, be withdrawn, and that another Office Action be mailed that is complete and accurate in all respects, thus restarting the period for response. Favorable action is earnestly solicited.

Respectfully submitted,

JAN 14 2002

Date


Alan I. Cantor
Reg. No. 28,163

FOLEY & LARDNER

Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

Telephone: (202) 672-5570

Facsimile: (202) 672-5399